

REMARKS

Claims 1, 2, 5, 7-10, 13, and 14 are pending and rejected with claims 1, 9 and 10 being independent. Claim 2 is cancelled.

Prosecution of the application was reopened after final Board decision reversing the Examiner.

The Applicants note that according to MPEP §1214.04, the Examiner should never regard a reversal by the Board as a challenge to make a new search to uncover other and better references. The Examiner claims to have specific knowledge of the existence of particular references which indicate nonpatentability justifying the reopening of prosecution. Applicants respectfully request that the Examiner demonstrates that such specific knowledge was not the product of a new search as it appears. As seen below, a multitude of references are cited in this rejection. It appears that the examiner should have filed a supplemental Examiner's Answer to have the Board consider these references. This only results in delaying the prosecution of this application through no fault of Applicants. The patent term should be adjusted accordingly.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, et al. (5,559,549, hereinafter Hendricks) in view of Gordon et al. (6,208,335, hereinafter Gordon).

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Gordon and Miller et al. (5,585,866, hereinafter Miller).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, Gordon and Miller as applied to claim 5 above, and further in view of Hoarty (5,485,197, hereinafter Hoarty).

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Gordon and Bolanos et al. (5,793,364, hereinafter Bolanos).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks and Gordon as applied to claim 1 above, and further in view of Bolanos.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks and Gordon as applied to claim 1 above, and further in view of MacInnis (5,951,639, hereinafter MacInnis).

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewriting to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Rejection Under 35 U.S.C. 103

Claims 1 and 2

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Gordon. Claim 2 is cancelled. The rejection is traversed.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP §2141.

According to MPEP §2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art" (*quoting, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). In addition, to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all elements of the subject claim. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (*citing, CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)).

The Office Action failed to establish a *prima facie* case of obviousness because the combination of Hendricks and Gordon fails to teach or suggest all the claim

elements. First, claim 1 is amended to incorporate the recitations of claim 2, which is neither taught nor fairly suggested by Hendricks and Gordon combined or alone. Specifically, the combination of Hendricks and Gordon fails to at least teach "wherein transmitting the bitmap for the channel information window is performed via an out-of-band channel." The Examiner cites Hendricks at col. 14:5-6 as disclosing the above recitation. (See Office Action, page 4). The Applicants respectfully disagree. This passage refers to using a separate channel full-time (large bandwidth) just for the menu information. There isn't even the slightest correlation between the cited disclosure and the claimed feature. The cleavage separating the two defies comparison. Furthermore, the Examiner acknowledges that Hendricks fails to disclose that graphic is a bitmap. (See Office Action page 4). Yet, the same Examiner asserts that Hendricks teaches: "wherein transmitting the bitmap for the channel information window is performed via an out-of-band channel."

Second, in rejecting claim 1, the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine the reference teachings. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144). In an attempt to articulate a motivation, the Examiner makes the following statement: "It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Hendricks to download the graphics as bitmaps, as taught by Gordon. Hendricks lacks any teaching as far as what specific file format the graphics are delivered to the receiver as, and it is thus up to the person of ordinary skill in the art to then decide on a file format for graphics. Gordon is evidence that it was quite well known in the art to use the bitmap format for precisely the type of graphical objects described by Hendricks, and would thus be an obvious choice to one of ordinary skill in the art." (See Office Action page 4). The Examiner fails to explicate why an artisan of ordinary skill in the art would be motivated to perform said modifications. The Examiner's conclusory statement is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection. *In re Sichert*, 566 F.2d 1154, 1164, 196

USPQ 209, 217 (CCPA 1977). The Applicants struggle to extract from the bogged statement some evidence or reasoning, but was unable to do so. Accordingly, the Examiner fails to meet the requirements set forth in MPEP §706.02(j).

As such, the combination of Hendricks and Gordon fails to teach or suggest all the claim elements. Accordingly, independent claim 1 is patentable under 35 U.S.C. 103(a) over the combination of Hendricks and Gordon. Furthermore, since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Hendricks and Gordon. Therefore, the rejection should be withdrawn.

Claims 5 and 8

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Gordon and Miller. The rejection is traversed.

Independent claim 5 is amended to recite in part: "wherein elements on a display screen can be selectively masked and displayed," which is neither taught nor fairly suggested by Hendricks in view of Gordon and Miller combined or alone. Further, claim 5 recites relevant limitations similar to those recited in independent claim 1. As such, for at least the same reasons discussed above, independent claim 5 also is patentable over Hendricks in view of Gordon.

Furthermore, Miller fails to bridge the gap between Hendricks and Gordon and Applicants' claim 1.

As such, the combination of Hendricks, Gordon and Miller fails to teach or suggest all the claim elements. Accordingly, independent claim 5 is patentable under 35 U.S.C. 103(a) over the combination of Hendricks, Gordon and Miller. Furthermore, since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Hendricks, Gordon and Miller. Therefore, the rejection should be withdrawn.

Claims 9 and 10

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Gordon and Bolanos. The rejection is traversed.

Independent claims 9 and 10 recite relevant limitations similar to those recited in independent claims 1 and 5. As such, for at least the same reasons discussed above, independent claims 9 and 10 also are patentable over Hendricks in view of Gordon.

Furthermore, Bolanos fails to bridge the gap between Hendricks and Gordon and Applicants' claims 9 and 10.

As such, the combination of Hendricks, Gordon and Bolanos fails to teach or suggest all the claim elements. Accordingly, independent claims 9 and 10 are patentable under 35 U.S.C. 103(a) over the combination of Hendricks, Gordon and Bolanos. Therefore, the rejection should be withdrawn.

Claims 7, 13 and 14

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, Gordon and Miller as applied to claim 5 above, and further in view of Hoarty. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks and Gordon as applied to claim 1 above, and further in view of Bolanos. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks and Gordon as applied to claim 1 above, and further in view of MacInnis. The rejections are traversed.

Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. 103 given Hendricks in view of Gordon. Since the rejection under 35 U.S.C. 103 given Hendricks in view of Gordon has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that the additional references supply that which is missing from Hendricks in view of Gordon to render independent claims 1 and 5 obvious, these grounds of rejection cannot be maintained. Therefore, the rejection should be withdrawn.

CONCLUSION

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 842-8110 X120 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

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